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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,498	01/31/2006	Tomoki Morioka	285615US0PCT	3694
22850 7590 04/02/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER HOLLOMAN, NANNETTE				
ART UNIT 1612		PAPER NUMBER		
NOTIFICATION DATE 04/02/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,498

Applicant(s)

MORIOKA, TOMOKI

Examiner

NANNETTE HOLLOMAN

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6,8,9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6,8,9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' arguments, filed December 18, 2008, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103 (Previous Rejection)

Claims 1- 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz et al. (US Patent No. 5,785,962) and further in view of Fath (UK Patent Publication No. GB 2321595 A). This rejection is maintained, and based on applicant's amendment, is now applicable to claims 11-14 and 17-22.

Applicant's Arguments

Applicant argues Hinz and Fath are silent in respect to (i) the use of two compositions for the treatment of hair and (ii) reduction in signs of bending of treated hair. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response

The use of a shampoo and conditioner together is simply a matter of common sense. Note that KSR v. Teleflex, 82 USPQ2d 1385, 1397 (U.S. 2007) has relaxed the

requirement for an explicit teaching in the prior art where the modification is simply a matter of applying common sense.

Because the combination of compositions comprises the same ingredients as recited in the instant claims, one of skill in the art would reasonably conclude that the combination would reduce the signs of bending of treated hair. Furthermore, this is not a limitation of the instant claims and therefore the references do not have to specifically teach this property to encompass the instant claims.

Moreover, Applicant has not done a proper comparison of the compositions of Hinz and Fath with the system of the instant claims. Applicant has not compared the shampoo of Hinz in combination with the conditioner of Fath, therefore an argument that a combination of the references would not encompass the limitations of the instant claims is not supported.

In regard to new claims 11-14 and 17-22, Hinz et al. disclose component (c) in the composition in an amount of 1.00 in example 2, column 5. Fath discloses component (b) lactic acid in the composition in an amount of 0.2 wt. % and component (c) glycerol in an amount of 0.50 wt. % in example 5, p. 13.

In regard to the pH when diluted with 20 times the weight with water, the compositions of Hinz (example 2) and Fath (example 5) are diluted to at least 20 times the weight of the components (a), (b) and (c) and the pH disclosed by Hinz is in the range of 4 to 7 and the pH of Fath is from 2 to 7.

A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have

expected them to have the same properties. See MPEP 2144.05. Consequently, it would have been obvious to one skilled in the art to reasonably expect the disclosure of Hinz et al. of a pH of 4 to have substantially the same properties as the claimed pH 3.9.

The prior art, Fath, discloses a pH of 2 to 7. Thus, the prior art differs from the instant claims insofar as it does not disclose the particular endpoints recited therein, i.e. 3 to 3.9. It is well-settled; however, that even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Accordingly, it since an overlap plainly exists here; it would have been obvious to have selected values within the overlap, consistent with the reasoning of the Peterson decision.

Therefore the combination of the references applies to the newly submitted claims.

New Rejection

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz et al. (US Patent No. 5,785,962) in view of Fath (UK Patent Publication No. GB 2321595 A) and further in view of Doi et al. (US Patent No. 6,923,954).

Hinz et al. in view of Fath as previously discussed differ from the instant claims insofar as the do not disclose the claimed aromatic alcohol or alkylene carbonate.

Doi et al. which is directed to a hair composition disclose a composition comprising organic solvents, i.e. benzyl alcohol, cinnamyl alcohol, ethylene carbonate and propylene carbonate (column 8, lines 29-39). Doi et al. disclose the use of these

organic solvents improve the feeling upon use, luster and suppleness (column 8, lines 59-61).

It would have been obvious to one of ordinary skill to have used the claimed organic solvents in the compositions of Hinz et al. in view of Fath motivated by the desire to use a component that improves the feeling upon use of the composition as disclosed by Doi et al.

No claim is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612